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In re Application of LIU et al	:	
U.S. Application No.: 10/589,068	:	
PCT Application No.: PCT/US2005/004729	:	
Int. Filing Date: 10 February 2005	:	DECISION
Priority Date Claimed: 11 February 2004	:	
Attorney Docket No.: Case 1004 US	:	
For: A METHOD FOR THE REMOVAL OF	:	
AGGREGATE PROTEINS . . .	:	

This is in response to applicant's "Petition Under 37 C.F.R. § 1.47(a)" filed 13 June 2007.

**BACKGROUND**

On 10 February 2005, applicant filed international application PCT/US2005/004729, which claimed priority of an earlier United States application filed 11 February 2004. The thirty-month period for paying the basic national fee in the United States expired on 11 August 2006.

On 10 August 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 13 April 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 13 June 2007, applicant filed the present petition under 37 CFR 1.47(a) along with an executed declaration.

**DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2)

factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by the available inventor on his/her own behalf and on behalf of the nonsigning inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

\* \* \*

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Ke Tang cannot be reached. However, the petition does not sufficiently illustrate that a diligent effort was made to find Tang. The statement of Cheryl Liljestrand provides documentary evidence of one attempt to locate Tang by mail (see copy of letter dated 18 July 2006). However, the petition fails to indicate whether such letter was successfully received. If the mailing address is correct, it would not be reasonable to allege that Tang cannot be located. Furthermore, the petition states that several telephone messages left for Tang. Again, if the telephone number used is correct, it would not be reasonable to allege that Tang cannot be found. In addition, the petition does not provide any details of other attempts to reach Tang, e.g. by electronic mail, by searching public directories, and by asking

Tang's former employer and co-workers. Thus, it would not be reasonable to conclude at the present time that Tang cannot be found after diligent effort.

If petitioner later alleges that Tang's conduct constitutes a refusal to sign, petitioner must demonstrate that a bona fide attempt was made to present a complete copy of the application papers (including specification, claims, drawings, and oath/declaration) to Tang for signature and that Tang actually received such papers. Furthermore, the petition must include a supporting affidavit from the person with firsthand knowledge of the refusal.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

### **CONCLUSION**

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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